

ROBERT E. BUSHNELL*†

JOSEPH C. SEEBER*

DARREN R. CREW*

MATTHEW J. LESTINA†*

SARYADVINDER S. SAHOTA†*

JONG H. PARK†

FRANK J. DYNDAA*

OF COUNSEL

RICHARD H. STERN*

MICHAEL D. PARKER

(REG. PATENT AGENT)

† ADMITTED IN MARYLAND

* ADMITTED IN VIRGINIA

+ ADMITTED IN PENNSYLVANIA

‡ ADMITTED IN NEW YORK

° ADMITTED IN CONNECTICUT

* ADMITTED IN NEW JERSEY

• NOT ADMITTED IN D.C.

R. E. BUSHNELL

ATTORNEY AT LAW

1522 K STREET, N.W., SUITE 300

WASHINGTON, D.C. 20005-1202

UNITED STATES OF AMERICA

INTELLECTUAL PROPERTY LAW

TELEPHONE (202) 408-9040

FACSIMILE (202) 289-7100

FACSIMILE (202) 628-3835

FACSIMILE (410) 747-0022

E-MAIL: REBUSHNELL@AOL.COM

6 May 2003

☐ U.S. Postal Service

☐ Via Local Courier

☐ Via International Courier

☐ Via Facsimile No. _____

☐ Via E-Mail Attachment

☐ Please Acknowledge Receipt

Attn.: Examiner Tupper

Art Unit: 2652

Assistant Commissioner for Patents

Washington, DC 20231

Via Hand Delivery

RECEIVED

MAY 08 2003

Technology Center 2600

Re: U.S. Patent **Reissue** Application for
*PSEUDO CONTACT TYPE NEGATIVE
PRESSURE AIR BEARING SLIDER*
Serial No.: 09/892,790
KI-OOK PARK et al.
Reissue of U.S. Pat. No. 5,917,679
Your Ref. : P9866-US/SE
Our Ref.: P56525RE

Dear Examiner Tupper:

In accordance with our telephone discussion, accompanying this courier delivery are three signed copies of a Substitute Reply Brief. I was on travel on the 28th of April, and the uncorrected copies of the Reply Brief were inadvertently submitted. Kindly replace those uncorrected copies with the accompanying Substitute Reply Brief.

Thank you for your assistance with this matter.

With best regards.

Respectfully submitted,


Robert E. Bushnell

REB/wc

Enclosures

ENTER
REPLACES
PAPER NO. 22
RST

RECEIVED

MAY 0 8 2003

Technology Center 2600

PATENT
P56525RE

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES**

In re Application of:

Appeal No. _____

KI-OOK PARK *et al.*

Original Patent No. 5,917,679 issued on 29 June 1999

Serial No.: 09/892,790

Examiner: TUPPER, ROBERT S.

Filed: 28 June 2001

Art Unit: 2652

For: PSEUDO CONTACT TYPE NEGATIVE PRESSURE AIR BEARING SLIDER

Attn: Board of Patent Appeals & Interferences

SUBSTITUTE REPLY BRIEF

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Examiner's Answer (Paper No. 20) mailed on the 27th of February 2003, Appellant respectfully requests substitution of this Reply Brief in lieu of the Reply Brief that was timely filed on the 28th of April 2003. By way of explanation, Applicant's Reply Brief timely filed on the 28th of April 2003 contained uncorrected typographical errors and omitted several of Appellant's footnotes. Those errors have been corrected in this Substitute Reply Brief, which provides the Board with a more readable statement of Applicant's arguments and remarks. No new issues are raised by the substitution of this Reply Brief.

Folio: P56525RE

Date: 05/05/2003

I.D.: REB/kf/wc

I. REAL PARTY IN INTEREST

Pursuant to 37 CFR §1.192(c)(1)(as amended), the real party in interest is:

SamSung Electronics Co., Ltd.
#416, Maetan-dong, Paldal-gu
Suwon-city, Kyungki-do, Republic of KOREA

as evidenced by the Assignment recorded in the United States Patent & Trademark Office on the 6th day of March 1998 at Reel 9030, frame 0967.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals and no interferences known to Appellant, Appellant's legal representatives or the assignee which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1 through 60 are pending in this application. Claims 1 through 20 have been allowed. Claims 21 through 60 stand finally rejected as stated in the final Office Action (Paper No. 9). Of the latter claims, claims 21, 31, 42, 52, 55 and 58 are independent, whereas the remaining claims are dependent.

IV. STATUS OF AMENDMENTS

Two Amendments were filed after the final Office action (Paper No. 9) mailed on 9 July 2002, amending claims 16, 21, and 31. The first amendment under 37 CFR §1.116(b) was filed

on the 9th of October 2002. In Paper No. 12, an Advisory Action dated on the 16th of October 2002, the Examiner stated that the proposed amendment would not be entered.

A second amendment under 37 CFR §1.116(b) was filed on the 27th of November 2002. In Paper No. 15 dated on the 5th of December 2002, the Examiner refused entry of the second amendment.

A third amendment under 37 CFR §1.116(b) was filed simultaneously with this Appeal Brief on the 9th of December 2002 to proposed only amendment of claim 16 in one instance. As of the filing date of this Appeal Brief, the Examiner has not yet considered the second amendment.

V. SUMMARY OF INVENTION

The *Examiner's Answer* asserted that,

“[t]he summary of invention contained in the brief is deficient because it fails to mention the first and second front projections defining air bearing surfaces (110a) and (110b), and the fourth projection (180) at the rear mounting transducer.”

37 C.F.R. §1.192(c)(5) requires that the “[t]he brief shall contain ... [a] concise explanation of the invention *defined in the claims involved* in the appeal” (Emphasis added). Despite the Examiner’s assertion, Appellant’s *Appeal Brief*“ complies with the requirements of 37 C.F.R. §1.192(c)(5).

In response to the Examiner’s assertion, Appellant notes that “air bearing surfaces (110a) and (110b),” are illustrated in Figures 4 through 12 and described in column 5, lines 13-25 and

column 6, lines 42-52; “and the fourth projection (180) at the rear mounting transducer” is illustrated in Figures 4 through 7 and is described in column 7, lines 32-41.

Turning now to the requirements of 37 C.F.R. §1.192(c)(5) that Appellant’s Brief contain a concise explanation of “the invention *defined in the claims involved* in the appeal ...” as opposed to all of the several embodiments disclosed in the specification but not defined in the claims involved in the appeal, Appellant directs the attention of the Board to Figs. 4 and 5, the pending claims define Appellant’s negative pressure slider for a hard disk drive with trailing air bearing surface platforms 110c and 110d symmetrically disposed on opposite sides on a longitudinal axis of the slider body 100 and aligned with one another in a lateral direction of the slider body 100, to provide a positive lifting force at the air outlet between the slider body 100 and the disc surface (not shown). Column 5, lines 25-32. As is explained in Appellant’s patent,

“these trailing ABS platforms 110c and 110d ... provide a positive lifting force at an air outlet between the slider body and the disc surface (not shown).” Column 5, lines 27-33.

An arcuate cross rail 130 extends across the principal surface 111 of the slider 100 between air bearing surface platforms 110c, 110d. Column 5, lines 37-41.

As explained in the original specification,

“[t]he arcuate cross rail 130 and the rear ABS platforms 110c and 110d together define a substantially U-shaped projection that extends from the principal surface 111 of the slider 110. The curvature of the cross rail 130 forms a negative pressure cavity 150, that may be somewhat rounded at the center of the slider body 110.” Column 5, lines 41-46.

The negative pressure cavity 150 functions to provide a downward pulling action on the slider

body 100, which in turn creates a gram load equivalent effect that enhances stability. Column 6, lines 4-7.

Another advantage of the arcuate configuration of the cross rail 130 resides in the fact that contaminants will have less of tendency to accumulate against the front wall of the cross rail. Column 6, lines 19-22. That is, contaminants will instead tend to travel along the arcuate front wall and exit off the side of the slider body between the gaps formed by the front corner ABS projections. Column 6, lines 22-25. This also enhances read/write performance of the slider 100 over the long-run. Column 6, lines 25-26.

VI. ISSUES

I. Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

A. Does 35 U.S.C. §251 Prohibit The Allowance Of Reissue Claims That Are Broader In Scope Than The Patented Claims?

B. Does 35 U.S.C. §251 Require That Reissue Claims Which Are Broader In Scope Than The Patented Claims Contain All Of The Constituent Elements Of The Narrowest One of Those Patented Claims?

C. Does 35 U.S.C. §251 Prohibit Allowance Of Reissue Claims That Are Patentably Distinguishable Over The Prior Art For Reasons That Are Different From The Reasons For Allowance Of The Patented Claims?

D. Did The Examiner Correctly Follow The Procedure Established By The Commissioner Of The United States Patent & Trademark Office For Making A Determination Of An Improper Recapture Under 35 U.S.C. §251?

E. Where Appellant Correctly Demonstrated That The Prior Art Fails To Teach

What An Office Action Represented That Art As Allegedly Teaching, Does Appellant's Demonstration Of Those Omissions In The Art Thereafter Create A Recapture Estoppel That Restricts The Scope Of Reissue Coverage To Only Reissue Claims That Recite Each And Every Item That Was Found Lacking In The Prior Art's Teaching?

F. May A Recapture Rejection Under 35 U.S.C. §251 Be Maintained Where The Office Action Fails To Make A Finding Of Which Aspects Of The Reissue Claims Are Broader Than The Patented Claims, And Fails To Provide Evidence That The Broader Aspects Relate To Surrendered Subject Matter?

G. Is This Particular Recapture Rejection Of Claims 21-60 Under 35 U.S.C. §251 An Improper, Back-door Attempt To Revive The *Point-of-novelty* Criterion For Patentability?

H. Do Alternative Statements Made By An Appellant To Explain The Impropriety Of A Rejection Under 35 U.S.C. §102 Constitute An Amendment Of The Rejected Claim Or Constitute A Surrender Of Patentable Subject Matter Under 35 U.S.C. §251?

I. Even Ignoring Arguendo A Lack Of Basis For Imposition Of A Rejection Under 35 U.S.C. §251 And The Doctrine Of Recapture, And A Failure Of The Examiner To Follow The Mandated Procedure Under *MPEP* §1412.02, Do Claims 21 Through 60 Each Define At Least One Of The Constituent Aspects Required By The Examiner To Avoid Recapture?

J. The Examiner's Assertion That *Appellant Specifically Identified Several Structural Features Recited In The Claims To Define Over The Prior Art Rejection Is A Non Sequitur* That Does Not Support The Examiner's Recapture Rejection Under 35 U.S.C. §251.

K. 35 U.S.C. §251 And The Doctrine Of Reissue Recapture Does Not Either Seize Upon Any Explanation Given By An Appellant In Support Of The Traversal Of An Art Rejection Or Use The Fact That Appellant Mentioned The Presence Of One Or More Aspects Of A Rejected Claim When Traversing An Art Rejection, As Creating An Insurmountable Bar To Allowance Of A Reissued Claim Which Fails To Recite the Identical Aspect Mentioned In The Appellant's Traversal.

II. Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. § 112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph (6) of the Examiner's Answer.

III. Rejection of Claims 21 through 60 Under First & Second Paragraphs of 35 U.S.C. §112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph (6) of the Examiner's Answer.

IV. Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

A. Where The Applied Art Fails To Disclose All Of The Elements Of The Rejected Claims, Can There Be An Anticipation Under 35 U.S.C. §102(a)?

B. Modification Of Nepela '981 In A Manner That Would Render Nepela '981 Inoperative, Is Impermissible To Support An Anticipation Rejection.

C. Whether Claims 21 And 31 Do, Or Do Not Preclude The Presence Of Other Air Bearing Surfaces in Addition To The U-Shaped Platform Is Irrelevant To Determinations Of Anticipation?

VII. GROUPING OF THE CLAIMS

Normally, these appeals may be briefed, argued and decided with one or two representative claims. Here, numerous issues are presented in the first Office action and repeated in the final Office action, sometimes with direct application to particular claims while ignoring others of the rejected claims, and in other instances to several or all of the reissue claims *en mass* without explanation of the application of the rejection to recognition of the distinctions and differentiations existing between the rejected claims. The claims do not

therefore, stand or fall together, and thus the claims are grouped and considered individually, for the reasons set forth in the following arguments.

Applicant notes that the several disparate issues raised by the Examiner, in conjunction with the need to address of each independent claim as a representative claim is representative of the extremeness of the Examiner's style of Examination, and is unnecessarily burdensome to the Appellant.

A. Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

In the Examiner's comments accompanying the rejection of claims 21 through 60 under 35 U.S.C. §251, the Examiner differentiated between independent reissue claims 21, 31, 42, 52, 55 and 58; consequently these claims must be grouped independently of one another; and therefore each of claims 21, 31, 42, 52, 55 and 58 are respectively representative of its own group, and stand or fall separately.

B. Rejection of Claims 21 through 41 Under Second Paragraph of 35 U.S.C. §112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph (6) of the Examiner's Answer.

C. Rejection of Claims 21 through 60 Under First & Second Paragraphs of 35 U.S.C. §112

The Examiner has implicitly withdrawn all rejections under 35 U.S.C. § 112, in paragraph

(6) of the Examiner's Answer.

D. Rejection Of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

Claims 21, 30 through 32 and 41 differ in language and scope from one another. The final Office action applied Nepela '891 to these claims collectively. Each of these claims is different in its text however, and each defines a different aspect of Appellant's inventions. Accordingly, each of these claims should be considered independently, and grouped separately in consideration of the rejection of these claims under 35 U.S.C. §102(a) as anticipated by Nepela'981.

VIII. ARGUMENT

I. Rejection of Claims 21 Through 60 Under 35 U.S.C. §251

As explained in Appellant's Appeal Brief, on page 2 of the Office action, the Examiner rejected claims 21-51 under 35 U.S.C. §251 "as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based." The Examiner's application of the doctrine of reissue recapture raised nine (9) separate issues, each of which Appellant addressed in the Appeal Brief. The Examiner has addressed none of these issues in the Examiner's Answer, and instead has raised the following additional issues, which Appellant now addresses.

J. The Examiner's Assertion That *Appellant Specifically Identified Several Structural Features Recited In The Claims To Define Over The Prior Art Rejection Is A Non Sequitur That Does Not Support The Examiner's Recapture Rejection Under 35 U.S.C. §251.*

On page 4 of the Examiner's Answer, paragraph 11, the Examiner argues that,

“[i]t is the Examiner's position that, in the parent application, *Appellant specifically identified several structural features recited in the claims to define over the art rejection* made against the originally filed claims in the parent application.” Examiner's Answer, pages 4 and 5.

The Examiner has distorted the last two paragraphs on page 11 and the first paragraph on page 12 of Appellant's amendment filed on the 1st of December 1998. The distortion is explained in greater detail in conjunction with the following issue. Additionally, the Examiner has improperly miscast Appellant's remarks in the amendment of the 1st of December 1998; those remarks were general statements supported by specific examples. Here, the Examiner seeks to mislead the Board by characterizing those remarks as arguments based upon “several structural features recited in the claims to define over the art rejection”, and hides from the attention of the Board that Appellant's statements on pages 11 and 12 of the amendment of the 1st of December 1998 begin with, include and conclude with four distinct general statements that traverse the anticipation rejection based upon Chapin '868:

- “Claims 1-3, 7, 9-19, and 21-25 are drawn to a negative pressure air bearing slider which includes”
- “Appellant respectfully submits that the claimed slider is not disclosed anywhere in Chapin.”
- “Likewise, none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25.”

- “Consequently, the difference between the Chapin and the present invention may be analogized to the difference between a river running through a plot of land (Chapin) and a lake with several islands located therein (the present invention).”

All four of these statements are general statements that emphasize the impropriety of the anticipation rejection and the unsuitability of Chapin ‘868 to support an anticipation rejection. The Board is invited to observe that the Examiner did not disagree with the technical accuracy of these statements. The Examiner’s acquiescence in the correctness of these general statements is revealed by the Examiner’s conduct, namely withdrawal of the anticipation rejection premised upon Chapin ‘868 in the next office correspondence. In the amendment of the 1st of December 1998, Appellant gave specific examples and did in fact refer to specific structural features of the pending claims to support the general traversal. The Examiner has fixated upon three (3) of those specific structural features, and ignores the fact that those structural features were included among nine (9) different references to structural features, presented either as exemplary features (such as, “which includes”) as additional evidentiary distinctions (that is, “also has”) or in the alternative (has neither ... “nor does it have”) or as a contrast with other features (“likewise, none”). The Examiner incorrectly infers that Appellant argued only specific structural features, and seeks to hide from the Board’s attention the fact that Appellant presented general statements and then supported those statements by numerous and alternative references to differences in specific details of the Chapin ‘868 reference and the rejected claims. This is particularly evident in Appellant’s last of the four general statements, where Appellant uses a metaphor of a river and a plot of land, neither of which could reasonably be asserted to be structural features of the

pending claims.

In the sole instance in which Appellant asserts that a structural feature “clearly distinguishes”, the references are to the “two trailing platforms, 110c and 110d.” Although both of these elements are present in these rejected claims, the Examiner has not mentioned this statement even though the statement is present in the second of the three paragraphs on pages 11 and 12 cited by the Examiner. Accordingly, the Examiner’s attempt to recast Appellant’s general explanation of the impropriety of the anticipation rejection as a specific argument by Appellant, is improper, ignores the Examiner’s subsequent conduct in withdrawing the rejection without amendment of any of the claims to include those specific examples supporting Appellant’s general statements, and fails to respond to the remarks of Appellant in pages 11 and 12 of the Amendment on the 1st of December 1998.

The *non sequitur*¹ is best demonstrated by the fact that if any of the nine (9) references set forth on pages 11 and 12 of Appellant’s 1st of December amendment were not present in the patent claims, those claims would still remain patentably distinguishable over Chapin ‘868 by the presence of any of the remaining eight (8) structural features mentioned in those paragraphs. In summary, the three paragraphs set forth on pages 11 and 12 of the 1st of December amendment simply direct the Examiner’s attention to the language of the claims and politely request the Examiner to read those claims while examining the drawings of Chapin ‘868 and emphasized

¹ Technically, this argument in the Examiner’s Answer is technically referred to as an *ignoration elenchi*, that is, a logical fallacy which consists in apparently refuting an opponent while actually disproving some statement different from that advanced by him (OED).

the speciousness of the anticipation rejection by pointing to nine (9) different structural distinctions, any of which support patentability.

K. 35 U.S.C. §251 And The Doctrine Of Reissue Recapture Does Not Either Seize Upon Any Explanation Given By An Appellant In Support Of The Traversal Of An Art Rejection Or Use The Fact That Appellant Mentioned The Presence Of One Or More Aspects Of A Rejected Claim When Traversing An Art Rejection, As Creating An Insurmountable Bar To Allowance Of A Reissued Claim Which Fails To Recite The Identical Aspect Mentioned In The Appellant's Traversal.

In the Examiner's Answer (paragraph 11), page 4), the Examiner asserts that:

“Appellant appears to be arguing that the rejection is not proper because the claims in the parent application were not narrowed in response to the rejection in the first Office action in the parent application. This is not determinative.”

Although the Examiner concedes that the condition precedent for the creation of reissue recapture, mainly amendment of a claim in order to overcome a prior art rejection, did not occur during prosecution of the parent application, the Examiner now asserts that the doctrine of reissue recapture prohibits allowance of any reissue claim that does not include all of the “structural features” that an Appellant mentioned in remarks traversing an anticipation rejection because the specific structural features mentioned in those remarks are absent from the rejected reissue claims. Specifically, the Examiner now maintains that:

“[i]t is the Examiner's position that, in the parent application, Appellant specifically identified several structural features recited in the claims to define over the art rejection made against the originally filed claims in the parent application” Examiner's Answer, page 4 and 5. The Examiner has attached pages 11 and 12 of Appellant's remarks in the amendment filed on the 1st of December 1998 in the parent application, and relies upon those

remarks to now assert that:

“Appellant specifically argued that the following structural features defined over the art cited in the 102 rejection of the originally filed claims in the parent: (A) an arcuate front wall (page 11, lines 16 and 21), (B) sidewall portions defining third and fourth air bearing surfaces (page 11, line 17-18 and 22), and (C) four separate air bearing surfaces (page 12, line 7-9).” Examiner’s Answer, page 5.

The manner in which the Examiner has truncated the remarks set forth in Appellant’s amendment of the 1st of December 1998, and distorts the meaning of the statements containing the phrases (A) through (C) listed by the Examiner. Appellant will examine each phrase individually.

(A) An Arcuate Front Wall and (B) Sidewall Portions Defining Third and Fourth Air Bearing Surfaces

The Examiner relies upon Appellant’s mention of “an arcuate front wall” on page 11, at lines 16 and 21 of Appellant’s amendment of the 1st of December 1998, and the absence of that identical phrase in reissue claims 21-60, as justifying invocation of reissue recapture to bar allowance of claims 21-60. The Examiner’s listing of “an arcuate front wall” is an excerpt taken from two different sentences set forth on page 11 of Appellant’s amendment of the 1st of December 1998. These two sentences read:

“Claims 1-3, 7, 9-19 and 21-25 are drawn to a negative pressure bearing slider which includes ‘a *U-shaped projection ... including an arcuate front wall ... for defining a negative pressured cavity therein.*’”

The second sentence in Appellant's amendment read:

“For example, Figure 3j cited by the Examiner shows a slider which clearly has neither a U-shaped projection with *an arcuate front wall portion for defining a negative pressure cavity ...* .”

The first of these sentences refers to the structure defined by rejected independent claims 1 and 21 to explain the relation between the U-shaped projection and the negative pressure cavity, while the second sentence explains Fig. 3j of Chapin '5,200,868 relied upon by the Examiner to support the anticipation rejection of claims 1 and 21. What the Examiner's paraphrase ignores in his citation of a particular phrase, “an arcuate front wall”, is that these statements are written in the alternative, in conjunction with the intervening statements of Appellant from which the Examiner extracted the second phrase “(B) sidewall portions defining third and fourth air bearing surfaces.” These two excerpts were part of three different sentences that were written in the alternative, the “arcuate front wall” as was set forth in lines 15-17 on page 11 and was followed by the sentence “the U-shaped projection also has first and second sidewall portions ...”; while the second occurrence of the phrase “an arcuate front wall” appears in a sentence that continues with the statement: “nor does it have third or fourth air bearing surfaces spaced apart on the slider.”

Moreover, the first and second sentences identified by the Examiner as (a) an arcuate front wall and (b) sidewall portions referred to the definition of Appellant's U-shaped projection in claims 1 and 21, while the third sentence set forth in lines 20-22 on page 11 of Appellant's 1 December 1998 amendment describes Figure 3 of Chapin U.S. 5,200,868 relied upon by the Examiner to support the anticipation rejection. A third sentence is also written in the alternative,

and in its entirety reads:

“For example, Fig. 3j cited by the Examiner shows a slider which clearly has *neither* a U-shaped projection with *an arcuate front wall portion for defining a negative pressure cavity*, *nor* does it have *third or fourth air bearing surfaces* spaced apart on the slider body.”

In short, lines 15-22 on page 11 of Appellant’s 1 December 1998 amendment explained to the Examiner the presence of certain phrases within rejected claims 1 and 21, and then contrasted the presence of alternative features in those claims with the teachings expressly cited by the Examiner in Fig. 3j of Chapin ‘868. The absence of either feature (Appellant wrote “neither..., nor” in the third sentence) in Chapin ‘868 provides no basis for the Examiner to infer that Appellant argued that these features, in combination, distinguished over the art; Appellant instead provided a partial litany of features in the rejected claims and demonstrated to the Examiner that none of those features were present in the art.

Furthermore, the Examiner completely ignores the Appellant’s intervening statement set forth in lines 18 and 19 on page 11 of the 1 December 1998 amendment. That sentence, in its entirety, reads:

“Appellant respectfully submits that the claimed slider² is not

² Appellant’s referral to the “claimed slider” is a generic name for Appellant’s apparatus, and supports Appellant’s position here that, without arguing a distinction based upon a single difference between the rejected claim and Chapin (cf. *Hester Industries v. Stein, Inc.* 46 USPQ2d 1641 (Fed. Cir. 1998) where the patentee had repeatedly emphasized during prosecution of the patent, that the “solely with steam” and “two sources of steam” features of the claims in attempting to distinguish over the prior art, but omitted those features from the reissued claims); in Appellant’s remarks to the Amendment of the 1st of December 2003, Appellant argued the overall insuitability of Chapin to support an anticipation rejection, without pinning that absence of anticipation on a single limitation (e.g. as per *Hester Industries*, “solely with steam”) and cited numerous alternative features to support Appellant’s traversal of the anticipation rejection.

disclosed anywhere in Chapin.”

Why the Examiner has ignored this statement is not explained. This statement summarizes the previous two statements, namely that Appellant’s reference to “an arcuate front wall” and “sidewall portions for defining third and fourth air bearing surfaces” was not an assertion that those particular phrases either individually or collectively patentably distinguished the rejected claims 1 and 21 over Chapin ‘868; instead lines 18 and 19 of page 11 is a broad statement that Appellants “claimed slider is not disclosed anywhere” by the Examiner’s cited art. The “claimed slider” is the preamble term used in claims 1 and 21 to generically define Appellant’s invention. The Examiner’s reliance upon phrases set forth on page 11 of that amendment that referred to particular structural features of Appellant’s slider is disingenuous because the Examiner is transferring the emphasis to those particular phrases, and completely ignoring Appellant’s statement that it is the “claimed slider” that “is not disclosed anywhere in Chapin”.³ Appellant’s use of particular phrases referring to structural features of the claim simply buttresses the broad assertion that the Examiner’s anticipation rejection based upon Chapin’868 is wholly unfounded and specious. The Examiner apparently agreed, and withdrew that rejection in the next correspondence.

The impropriety of the Examiner’s reliance upon specific isolated phrases appearing in Appellant’s remarks, which the Examiner has taken in isolation and out of context, ignores the overall tenor of the entirety of Appellant’s remarks on pages 11 and 12, lines 15-22 and 1-11,

³ Unlike *Hester Industries*, Appellant made this statement but once, and the Examiner concurred, withdrew the rejection and allowed all of the pending claims.

respectively. The Examiner's out-of-context quotation of Appellant's arguments ignores that Appellant has presented arguments generally and repeatedly emphasizing that neither the embodiment shown "in Fig. 3j cited by the Examiner" or "none of the numerous other embodiments shown in Chapin disclose a slider according to any of the claims 1-3, 7, 9-19, and 21-25." Amendment of 1 December 1998, page 12, lines 3 and 1-2.

(C) Four Separate Air Bearing Surfaces

In lines 3-11 on page 12 of Appellant's 1 December 1998 amendment, Appellant continued the explanation that Chapin '868, generally failed to anticipate Appellant's claims. In the third sentence of that paragraph, Appellant wrote,

"instead, as shown in Fig. 4 and recited in independent claims 1 and 21, there are four separate air bearing (ABS) platforms 110a, 110b, 110c and 110d distributed at the four edges of the surface."
Page 11, lines 7-9.

This specific statement from which the Examiner has taken the phrase "four separate air bearing surface[-s]" is simply what the preceding sentence emphasizes, a contrast between the general disclosure of Chapin '868 and Appellant's claims. Nowhere does Appellant argue that the presence of four air bearing surfaces is the sole basis for avoiding anticipation by Chapin '868, as is inferred by the Examiner's argument. Instead, the subsequent two sentences, namely Appellant's statements that "The two trailing platforms, 110c and 110d, are connected by crossrail 130 to create a negative pressure pocket. *This clearly distinguishes* the slider of claims 1-3, 7, 9-19, and 21-25 for the present invention from Chapin." It seems that the Examiner has

transferred Appellant's argument of a particular feature that patentably distinguishes over the art, from Appellant's statement about the "two trailing platforms", to Appellant's earlier statements about "four separate air bearing surface platforms" in a misguided effort to create a recapture estoppel.

In summary, the Examiner's Answer mischaracterizes Appellant's remarks by improperly excerpting phrases from those remarks that name specific structural features, and then suggesting that those phrases are argued by Appellant in order to distinguish over the prior art. The impropriety is revealed by the reading of the entirety of both paragraphs, where Appellant argues generally "that the claimed slider is not disclosed anywhere in Chapin" and "none of the numerous other embodiments shown in Chapin discloses a slider according to any of the claims." The Examiner's effort to transfer the emphasis from the specific structure mentioned in lines 9-11 on page 12 of the remarks to the earlier mention of "four separate air bearing surface (ABS) platforms" emphasizes the subtlety of the Examiner's improper assertion of recapture estoppel. Lines 7-9, as contrasted with lines 9-11, refer to the contrast between Fig. 3j cited by the Examiner in Chapin and Appellant's Fig. 4 in claims 1 and 21. Often during prosecution, it is necessary to make these contrasts in order to assist the Examiner by focusing the Examiner's attention to the details of the prior art cited by the Examiner.

The impropriety of the Examiner's attempt to recast Appellant's remarks as an argument about specific structural limitations while ignoring the fact that Appellant's remarks argued generally, rather than specifically, that the claims were not anticipated as further highlighted by the Examiner's failure to consider that in the second paragraph, lines 3-11 on page 12, Appellant

actually argued about the siderails, the presence or absence of broken sections within the siderails, and siderails connected from the leading edge to the trailing edge, as well as the connection provided by crossrail 130. Additionally, in the first paragraph, lines 15-22 on page 11 and lines 1 and 2 on page 12, Appellant argued in the alternative in each instance. The “sidewall portions” was preceded by the introductory phrase “also has” while the second occurrence of “an arcuate front wall portion” is preceded by the introductory phrase “for example” and is followed by the phrase “nor does it have third or fourth air bearing surfaces.” As written, Appellant has argued generally, rather than specifically, and emphasized the general argument with these examples of deficiencies in Chapin ‘868, any of which serve to patentably distinguish the rejected claims from Chapin.⁴

⁴ Under 37 CFR §1.111(b), in order to be entitled to reconsideration or further examination, the Applicant must provide a written reply, and that “reply must present arguments pointing out the specific distinctions believed to render the claims ... patentable over the applied references.” The Examiners implementation of reissue recapture estoppel in the instant application argues that in 100% of the patents where an Applicant responds to an anticipation rejection, that Applicant’s compliance with the express requirement of 37 CFR §1.111(b) forever after estops the Applicant from obtaining allowance of any reissue claim that defines an apparatus that is structurally different from that defined by the patent claim, simply because that reissue claim lacks the “specific distinctions [that were] believed to render the [patent] claims ... patentable over any applied references.” This wholesale and blanket estoppel applies even where, as here, the anticipation rejection was frivolous and unwarranted by the prior art. Appellant here is not endeavoring to reargue the anticipation rejection based upon Chapin, because the Examiner has already concurred in the impropriety of that rejection, as is evidenced by the Examiner’s withdrawal of that rejection and allowance of all of the patent claims. Moreover, Applicant did not endeavor to narrow the scope of coverage of the patent claims in an effort to avoid Chapin, but simply explained to the Examiner, in compliance with 37 CFR §1.111(b) why Chapin was an improper anticipation reference. Applicant’s compliance with the rules of practice can not be said to create a reissue recapture estoppel that prevents Applicant from claiming other inventions disclosed in Applicant’s original specification.

IV. Rejection of Claims 21, 30-32, and 41 Under 35 U.S.C. §102(a) Over Nepela '981

The Examiner's Answer has not addressed the issue raised in Appellant's Appeal Brief, and summarily seeks to dismiss Appellant's analysis of the anticipation rejection by stating that "Appellant's references to the siderails (112, 114) are not on point." Instead, the Examiner raises two additional issues which Appellant addresses below.

B. Modification of Nepela '981 in a Manner That Would Render Nepela '981 Inoperative, is Impermissible to Support an Anticipation Rejection

The Examiner's Answer asserts that "Appellant seems to have ignored cited Fig. 5c of Nepela et al. This figure clearly shows a negative pressure slider with U-shaped air bearing platform (108) which surrounds and defines a negative pressure cavity (area between the legs of the U) with not more than two separate air bearing platforms (the leg portions)." The Examiner seems to refer to centerpad 108 illustrated in Fig. 5C of Nepela '981, and asserts that this structure meets Appellant's:

"a U-shaped air bearing platform defining a negative pressure cavity on said principle surface, said U-shaped air bearing platform comprising not more than two separate air bearing platforms each extending rearwardly toward said rear portion of said principle surface and respectively terminating any first rear termination and a second rear termination"

Nepela '981 teaches that "a central negative pressure region 128 that is aft of the centerpad 104 is etched to a nominal depth of about two hundred micro inches below the air bearing surface." Column 6, lines 8-11. Whether the U-shaped region between the two short legs of centerpad 108 in the embodiment illustrated in Fig. 5c of Nepela '981 also provides an additional negative pressure region is irrelevant. What the Examiner has ignored is that the features of claims 21

and 31 which the Examiner asserts are taught by Fig. 5c of Nepela '981 both define "a U-shaped air bearing platform" with "at least one of said not more than two separate air bearing platforms including a sidewall portion." The presence of siderails 112, 114 in Fig. 5c of Nepela '981 prevent either of the short legs of centerpad 108 from serving as the "sidewall portion" defined by Appellant's claims 21 and 31. Moreover, distortion of either leg of centerpad 108 to displace either siderail 112, 114 would destroy the symmetry consistently taught throughout Nepela '981. The need for such an impermissible modification of Nepela '981 is convincing evidence of the lack of anticipation of either claim 21 or 31 by Nepela '981.

C. Whether Claims 21 and 31 do, or do not Preclude the Presence of Other Air Bearing Surfaces in Addition to the U-Shaped Platform is Irrelevant to Determinations of Anticipation

The Examiner now argues that rejected claims 21 and 31 "do not preclude the presence of other air bearing surfaces in addition to the U-shaped platform. Note also that these claims do not define the size or extent of the negative pressure cavity. The slider shown in Fig. 5c has ALL of the structural features recited by these claims." As was demonstrated in the discussion of the foregoing issue, Fig. 5c of Nepela '981 cannot be read to meet both Appellant's U-shaped air bearing platform comprising not more than two separate air bearing platforms, each extending rearwardly" and "at least one of said not more than two separate air bearing platforms including a sidewall portion." In short, the Examiner's assertion that claims 21 and 31 "do not preclude the presence of other air bearing surfaces" is a misleading and confusing argument. The feature attacked by the Examiner is only Appellant's "U-shaped air bearing platform",

which defines specific air bearing surfaces, and does not purport to either define or exclude other air bearing surfaces upon the principal surface. What Nepela '981 lacks is this specific U-shaped air bearing platform. The ability of claims 21 and 31 to read upon other sliders which have air bearing platforms located at other parts of the principal surface is irrelevant to the question of whether centerpad 108 anticipates Appellant's U-shaped air bearing platform, as defined by claims 21 and 31. The Examiner has incorrectly considered only isolated limitations in Appellant's definition, and has failed to consider Appellant's definition of the U-shaped air bearing platform in its entirety. In view of the inability of Nepela '981 to meet the entirety of these features of Appellant's U-shaped air bearing platform, there is no anticipation.

IX. CONCLUSION

The Examiner's efforts to misread and mischaracterize the specific examples presented in the alternative on pages in the general statement of non-anticipation set forth in the three paragraphs on pages 11 and 12 of the amendment filed on the 1st of December 1998 is a *non sequitur* that fails to respond to either those general arguments, or to recognize that the references to the nine different structural features were presented in the alternative and as exemplars buttressing the general statement that Chapin '868 failed to provide a proper vehicle to support an anticipation rejection.

This brief is filed in triplicate. No fee is incurred by this Reply Brief.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. E. Bushnell", is written over a horizontal line.

Robert E. Bushnell,
Attorney for the Appellant
Registration No.: 27,774

1522 "K" Street N.W., Suite 300
Washington, D.C. 20005
(202) 408-9040